

JUDGE KOELTL

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

ROBERT G. LOPEZ, an individual,

Plaintiff,

v.

SKREENED, LTD., and DANIEL
FOX

Defendants.

17 CV 142

Civil Action No.

JURY TRIAL DEMANDED

**COMPLAINT FOR TRADEMARK INFRINGEMENT,
UNFAIR COMPETITION AND RELATED CLAIMS**

Plaintiff, Robert G. Lopez, alleges his complaint against Defendants, Skreened, Ltd., and Daniel Fox as follows:

NATURE OF THE ACTION

1. This action arises from Defendants infringement of Plaintiff's "ownership" and exclusive "use" rights in the mark LES NYC®, in conjunction with clothing and other related goods. Despite Plaintiff being the registered owner of the trademark LES NYC® and offering various clothing items under such brand name, the Defendants have infringed Plaintiff's rights in the aforementioned mark by selling, and offering for sale clothing items under Plaintiff's trademark. Plaintiff has already experienced "actual confusion" in connection with this matter and is likely to continue to experience confusion as to the affiliation or connection between the Defendant and Plaintiff resulting in the unjust enrichment of Defendant by using Plaintiff's registered trademark. Moreover, Plaintiff initially sent a cease-and-desist notice to Defendants on May 3, 2011 regarding Defendants infringement of Plaintiff's trademarks and Plaintiff also initiated litigation against Defendants in 2016 so Defendants have been well aware of Plaintiff's

U.S. DISTRICT COURT
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U.S. DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

claim of ownership rights in the aforementioned trademark deeming their current acts of infringement to be willful and in blatant disregard of Plaintiff's rights.

JURISDICTION AND VENUE

2. This Court has jurisdiction over this action pursuant to 15 U.S.C. §1051 *et seq.*, 15 U.S.C. Sections 1114-1116; under Section 43(a) of the Trademark Act, 15 U.S.C. §1125(a) and Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c).

3. This Court has personal jurisdiction over the Defendants because Defendants engage in business activities in, and directed to the State of New York within this judicial district and mail and ship clothing items from its printing and clothing business to locations in New York County and because Defendants have committed tortious acts aimed at and causing harm within the State of New York and this judicial district.

4. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1331(b) and (c) because it is where Plaintiff resides and the Defendant transact business in this district, and because a substantial portion of the events giving rise to the asserted claims have occurred, and continue to occur, within this district. Furthermore, the damage to Plaintiff and its intellectual property described herein continues to occur in this judicial district.

THE PARTIES

5. Plaintiff, Robert G. Lopez is an individual residing at 230 Clinton Street, Apt. #11C, New York, NY 10002.

6. Upon information and belief, Defendant Skreened Ltd., is an Ohio Limited Liability Company with a principal place of business at 2887 Silver Drive, Columbus, Ohio 43211.

7. Upon information and belief, Defendant Daniel Fox is the owner and registered agent of Skreened, Ltd. and resides at 1262 Bryden Road, Columbus, Ohio 43205.

FACTS

8. Since at least as early as 1999, Plaintiff Robert G. Lopez has been selling headwear, t-shirts, sweaters, hooded sweatshirts and other clothing items under the LES NYC® brand name.

9. Since at least as early as 1999, Plaintiff has been independently operating a clothing business under the trade name L.E.S. CLOTHING CO.™, which has sold headwear, t-shirts, sweaters, hooded sweatshirts and other related clothing items under the mark LES NYC®. Since at least as early as 2010, Plaintiff has also been selling clothing items under the mark LOYALTY EQUALS STRENGTH™ which is a representation of the LEST™ brand acronym.

10. In addition to selling and offering for sale clothing items under the LES NYC® and LOYALTY EQUALS STRENGTH™ brand names, Plaintiff has also continuously sold and offered for sale various clothing items including t-shirts which bear the LES NYC® mark in various font and design styles which are prominently displayed on the front and/or back of the headwear, t-shirts and/or sweaters.

11. Plaintiff sells, and promotes the sale of his clothing via his website www.lesclothing.com, through order forms, and his t-shirts and sweaters are also available for sale in several retail locations in New York and other States.

12. Plaintiff advertises his LES CLOTHING CO™, and LES NYC® brands and clothing items through flyers, posters, stickers and through grass root street marketing methods such as painted “street murals.” Plaintiff also regularly conducts photo shoots of customers who purchase his LES NYC® clothing items to be included in magazine advertisements and other marketing materials.

13. Plaintiff is the registered owner of United States Trademark Registration No. 4,549,880 for the mark LES NYC®. (See Exhibit A).

14. Plaintiff is the registered owner of New York State Trademark Registration No. R31259 for the mark LES NYC™. (See Exhibit B).

15. Plaintiff is informed and believes and thereon alleges that Defendants are marketing, promoting, selling and offering for sale various t-shirts bearing the LES NYC™ mark depicted in the pictures below and also promoting the t-shirts under the title, heading and keywords "LES NYC T-Shirts" on its website www.skreened.com. (See Exhibit C).



16. Plaintiff initially contacted Defendants in a May 3, 2011 Cease-and-Desist letter in which Plaintiff advised Defendants of his ownership rights in the LES NYC® mark regarding earlier LES™ related designs that were promoted and offered for sale via Defendants' website www.skreened.com. (See Exhibit D).

17. In a May 3, 2011 email correspondence, Defendant Daniel Fox, who is the owner, registered agent and incorporator of Defendant Skreened, Ltd. responded to the Cease-and-Desist letter and acknowledged Plaintiff's rights in the LES NYC® mark and removed the designs that were the subject of the initial Cease-and-Desist notice. (See Exhibit E).

18. On May 26, 2016, Plaintiff filed a trademark infringement action against Plaintiff's over their use of Plaintiff's LOWER EAST SIDE™ trademark used by Defendants on several t-shirts that displayed and promoted for sale t-shirts bearing Plaintiff's separately registered trademark. Despite acknowledging and being aware of Plaintiff's ownership rights in LES NYC® and other similar marks and even complying with Plaintiff's earlier Cease-and-Desist demands and reaching a settlement in the earlier filed action, Defendant's re-introduced and started promoting, selling and offering for sale additional designs bearing the LES NYC™ mark in blatant disregard of Plaintiff's ownership rights in the aforementioned mark.

19. Defendants use of Plaintiff's LES NYC® brand in connection with clothing has already caused and will continue to cause confusion as to the source or affiliation of the source of the clothing related goods under the LES NYC® mark.

20. Defendant Daniel Fox, as the owner of Defendant Skreened, has the right and ability to supervise the infringing activity alleged herein, and has a direct financial interest in Defendant Skreened, and as such is jointly and severally liable with Defendant Skreened.

FIRST CAUSE OF ACTION
TRADEMARK INFRINGEMENT (15 U.S.C. §§ 1114-1116)

21. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 20 of this Complaint.

22. The use in commerce by Defendants of an identical and slightly identical version of Plaintiff's registered trademark is likely to cause confusion, mistake and deception among members of the public and in trade as to the source, origin, or sponsorship of defendants' goods and services. Such use by defendant constitutes a clear and direct infringement of Plaintiff's rights in and to Plaintiff's registered trademark, and has resulted in injury and damage to Plaintiff that will continue if Defendants are not ordered to cease all use of the LES NYC® mark.

SECOND CAUSE OF ACTION

UNFAIR COMPETITION & FALSE DESIGNATION OF ORIGIN (15 U.S.C. § 1125(a))

23. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 22 of this Complaint.

24. Plaintiff has the exclusive right to market, brand and provide clothing related goods using the LES NYC® mark in connections with t-shirts and related goods.

25. Defendants by reason of the aforementioned acts, have falsely described, represented and designated the origin of its goods and services. Defendants' activities already have confused the public into believing that Defendants and Plaintiff's clothing goods and accessories come from one and the same source, and defendants continued activities are likely to create further confusion and deceive the public concerning the source of the goods/services.

26. Defendants have unfairly profited from the actions alleged herein and will continue to unfairly profit and become unjustly enriched unless and until such conduct is enjoined by this Court.

27. By reason of Defendants willful acts conducted in conscious disregard for Plaintiff's rights, Plaintiff is entitled to treble damages under 15 U.S.C. § 1117(a).

THIRD CAUSE OF ACTION

COMMON LAW TRADEMARK INFRINGEMENT & UNFAIR COMPETITION

28. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 27 of this Complaint.

29. Defendants conduct constitutes deception by which Defendants goods will be palmed off as those of Plaintiff. Such conduct constitutes trademark infringement and unfair competition in violation of the laws of the State of New York.

30. Defendants unauthorized use of Plaintiff's LES NYC® mark is likely to continue to cause further confusion to the public as to the clothing goods and accessories of the respective parties.

31. By reason of the foregoing, Defendants have infringed and continue to infringe on Plaintiff's common law rights in the LES NYC® marks and Defendants have become unjustly enriched by such acts of infringement.

32. Defendants unlawful conduct has been and will continue to be willful or willfully blind to Plaintiff's rights, as Defendant has reason to know of Plaintiff's rights.

**FOURTH CAUSE OF ACTION
UNJUST ENRICHMENT**

33. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 32 of this Complaint.

34. Defendants have unjustly retained profits from the sale of clothing goods and accessories bearing Plaintiff's LES NYC® mark.

35. Defendants actions constitute unjust enrichment.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully prays for relief as follows:

1. Entry of an order and judgment requiring that all defendant, its subsidiaries, officers, agents, servants, employees, owners, and representatives, and all other persons or entities in active concert or participation with them, be preliminarily and, thereafter, permanently enjoined and restrained from (a) using in any manner the trade name, trademark, domain name or other indicia or origin, including in whole or part the term LES NYC®, or any colorable

imitation thereof; (b) advertising, operating a website, using business stationary or offering any goods or services using the trade name, trademark, domain name, URL, or any other indicia of origin including in whole or part the terms LES NYC®, or any colorable imitation thereof; (c) otherwise engaging in any acts of unfair competition and infringement which tend to injure Plaintiff's rights in the LES NYC® mark.

2. That Defendant be required to account to Plaintiff for any and all profits derived by it, and to compensate Plaintiff for all the damages sustained by reason of the acts complained of herein, and that the damages herein be trebled pursuant to the Trademark Act.
3. That Defendant be ordered to deliver up for destruction any and all infringing materials bearing the LES NYC® mark, and any colorable imitation thereof, in whole or part.
4. That Plaintiff be awarded punitive and treble damages for Defendant's egregious and willful acts in disregard for Plaintiff's exclusive use rights in his federally registered trademark in connection with clothing.
5. That Defendant be required to place advertisements or send notifications to past and present customers that it improperly has been using the LES NYC® mark.
6. That Plaintiff be awarded the cost and disbursements of this action.
7. That Plaintiff have such other and further relief as the Court deems just and proper.

JURY DEMAND

Pursuant to Federal Rule of Civil Procedure 38(b), Plaintiff hereby demands a trial by jury as to all issues.

Dated: January 9, 2017
New York, New York

Respectfully submitted,
Robert G. Lopez – Pro Se



Robert G. Lopez
Pro Se Plaintiff
230 Clinton Street – Apt. #11C
New York, New York 10002
(917) 868-1698

EXHIBIT A

United States of America
United States Patent and Trademark Office

LES NYC

Reg. No. 4,549,880

LOPEZ, ROBERT G. (UNITED STATES INDIVIDUAL)
230 CLINTON STREET - APT. #11C
NEW YORK, NY 10002

Registered June 17, 2014

Int. Cl.: 25

FOR: BASEBALL CAPS AND HATS; HOODED SWEATSHIRTS; SHORT-SLEEVED OR LONG-SLEEVED T-SHIRTS; T-SHIRTS, IN CLASS 25 (U.S. CLS. 22 AND 39).

TRADEMARK

FIRST USE 12-0-1999; IN COMMERCE 12-0-1999.

PRINCIPAL REGISTER

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SEC. 2(F).

SER. NO. 85-335,314, FILED 6-1-2011.

ALICE BENMAMAN, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

EXHIBIT B

New York State Department of State Certificate of Trademark Registration

I Daniel E. Shapiro, Special Deputy Secretary of State, do certify that the Trademark described below and depicted on the attached copy has been duly registered in this Department pursuant to Article 24 of the General Business Law. This registration will remain in force for TEN years from the Date of Registration.

Registration Number: R31259

Registration Date: 05/12/08

Applicant: ROBERT G. LOPEZ

230 CLINTON STREET, SUITE #11C
NEW YORK

NY 10002-

*State of Incorporation or
Partnership Organization:*

Class Numbers: 25

Date First Used in NYS: 12/1999

Date First Used Anywhere: 12/1999

Trademark Description:

The mark is comprised of the words LES NYC inside of a circular design made up of stars.

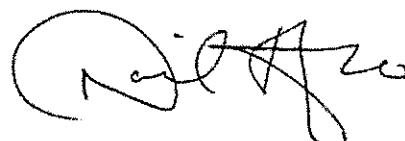
Description of Goods:

Clothing, namely: T-shirts, Hooded Sweatshirts, Vest, Hats and Caps as adopted from the USPTO.

*WITNESS my hand and the seal of the State of New York In
the City of Albany on this:*

Tuesday, June 10, 2008

by:



Special Deputy Secretary of State



EXHIBIT C

Up To 30% Off- Shop Now!



Size

XS	S	M	L
XL +\$1.50	2XL +\$1.50	3XL +\$1.50	

[Fit Guide](#)

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Up To 30% Off- Shop Now!



Size

XS	S	M	L
XL	2XL +\$1.50	3XL +\$1.50	

[Fit Guide](#)

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EXHIBIT D

GM ii

Robert G Lopez <lesclothing@gmail.com>

Trademark Infringement Concerns

Robert G Lopez <lesclothing@gmail.com>
To: daniel@skreened.com

Tue, May 3, 2011 at 2:29 PM

Dear Daniel:

Please see the attached letter regarding my trademark infringement concerns.

--
ROBERT G. LOPEZ
D/B/A L.E.S. CLOTHING CO.
(917) 868-1698
LESCLOTHING@GMAIL.COM

 Skreened.com.C.n.D..pdf
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ROBERT G. LOPEZ
D/B/A L.E.S. CLOTHING CO.
230 CLINTON STREET - HC
NEW YORK, NEW YORK 10002

May 3, 2011

**VIA FIRST CLASS MAIL
AND EMAIL COPY**

Intellectual Property Rights Agent
Skreened.com
3327 N. High Street
Columbus, Ohio 43202
Attn: Daniel

Re: Trademark Infringement Concerns

Dear Daniel:

For many years, I have been operating an independent Clothing company under the name L.E.S. Clothing Co. that sells t-shirts, hooded sweatshirts and various other clothing items under the marks **LOWER EAST SIDE™**, **LES NYC™** and various other variations of the aforementioned marks.

It has recently been brought to my attention that Skreened.com is both manufacturing and selling a t-shirt bearing the mark L.E.S., which is an abbreviation of the mark **LOWER EAST SIDE™**. The product I am referencing can be found on your company website www.skreened.com under item no. 578935-2001-WHI. I am enclosing a print-out of the item for your review.

I note that I have expended significant time, resources and finances in building the **LOWER EAST SIDE™** brand and I sell and promote my **LOWER EAST SIDE™** clothing items online via my website www.lesclothing.com and www.facebook.com/lesclothing.

Moreover, I am the owner of New York State Trademark Registration No. R31067 for the mark **LOWER EAST SIDE™** (copy enclosed) and also have common law rights in such mark by virtue of using and selling clothing in various states under the **LOWER EAST SIDE™** mark. Additionally, I am also the owner of New York State Trademark Registration No. R31259 for the mark **LES NYC™**, and have been using the above-referenced marks since at least as early as December of 1999 in conjunction with "clothing, namely; t-shirts, hooded sweatshirts, and caps." I also note that I have sought copyright protection for my **LOWER EAST SIDE™**

April 14, 2011

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artwork, designs and product order forms and do currently hold copyright registrations for some works that incorporate LOWER EAST SIDE™ and L.E.S.™ artwork.

Your companies use, manufacture and sale of similar goods bearing an identical mark constitutes trademark infringement, unfair competition and trademark counterfeiting under state law and in violation of the Lanham Act, 15 U.S.C. §1114 et. seq.

Trademark ownership rights are acquired by (i) the first person or entity to use the mark in commerce, and/or (ii) the first person or entity that registers the mark. In this instance, that is I. Your subsequent (and continuing) use of any variation of the LOWER EAST SIDE™ mark has caused, and will continue to cause confusion as to the source of the clothing under that mark.

In view of the above, I am demanding that you immediately (i) cease-and-desist from any further use of any variation of the LOWER EAST SIDE™ mark, (ii) completely remove any and all LOWER EAST SIDE™ clothing items from your company website (iii) provide us with a complete listing of your current inventory of LOWER EAST SIDE™ t-shirts, and (iv) provide us with documentation accounting for the dollar amount and number of t-shirts bearing LOWER EAST SIDE™ that have been sold to date.

After you have complied with the above demands, we will be in a position to negotiate a settlement for any past infringement. If you do not comply with my demands, I will be left with no alternative but to initiate litigation to protect my intellectual property rights.

For your information, I have already enforced my ownership rights in the LOWER EAST SIDE™ mark against Payless Shoesource Worldwide, Inc.; J. Crew International, Inc.; Aeropostale, Inc., CafePress.com, PrintMojo, LLC and several other parties who have utilized my trademark on clothing. I am giving Skreened.com an opportunity to take immediate corrective action to eliminate the possibility of being named as a defendant in a federal trademark infringement action.

I invite you to contact me to determine if a resolution to this dispute can be achieved. I would expect to hear from a representative of Skreened.com no later than May 12, 2011.

Very truly yours,

L.E.S. CLOTHING CO.



Robert G. Lopez

Enclosures

SKREENED

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Search Skreened

SEARCH

LOWER EAST SIDE



Select Product: Mens / Unisex : T-Shirts

American Apparel Unisex Fitted Tee
\$39.99

America
Organic
\$40.99

\$39.99

Small

ADD TO CART

Description: L.E.S.

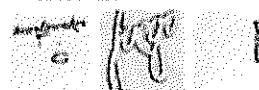
Search: [NYC](#), [new york](#), [Lower east side](#)

American Apparel Unisex Fitted Tee / White

The perfect 100% cotton t-shirt has a fitted / vintage fit. The medium-weight jersey fabric is made of ultra-soft combed cotton.

Size Chart

[View more designs](#) in the shop, "Whiskey and Ginger."



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ITEM STATUS: IN STOCK

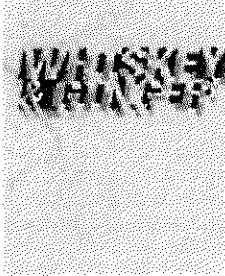
SEE OTHER DESIGNS IN THIS SHOP

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WHISKEY
AND
GINGER

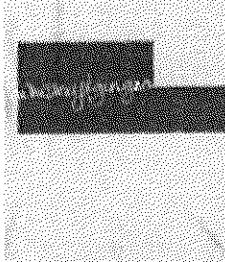


MATA
GATA
PITUS
READY

L.E.S
IS
MORE



YES
WEARING
SNEAKERS



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EXHIBIT E



Robert G Lopez <lesclothing@gmail.com>

Trademark Infringement Concerns

Daniel Fox (skreened.com) <daniel@skreened.com>
To: Robert G Lopez <lesclothing@gmail.com>

Tue, May 3, 2011 at 2:34 PM

Mr. Lopez,

Thank you for bringing this matter to our attention. The designs have been removed from our marketplace for violating our Terms of Service and User Agreement.

As you may know, Skreened is a marketplace of user generated content. We have strict guidelines outlining appropriate user behavior and protecting intellectual property as outlined in our site's terms of use. At times, however, users may misunderstand or misrepresent their right to recreate the content which they have published. When this comes to our attention, it is our policy to swiftly remove the infringing material from our site, and send a take-down notice to the user.

Regards,
Daniel Fox
Skreened.com
[Quoted text hidden]

—
Daniel Fox
President, Skreened
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